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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/714,987	09/17/96	SHARKEY	H 17616-705

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QM22/0131

EXAMINER

SHAY, D

ART UNIT

PAPER NUMBER

3739

DATE MAILED:

01/31/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/714,987

Applicant(s)

Sharkey et al

Examiner

L Shay

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on September 30, 1997.
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-29 is/are pending in the application.  
Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-29 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 7/10/15, 17-20
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are indefinite because the recitation that the energy delivery device has "a coaxial distal portion" is unclear, as there is no element recited with which the device is to be "coaxial".

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makower in combination with Ishik<sup>h</sup>kara et al. Makower teaches a device such as claimed except <sup>n</sup> the blunt periphery, the use of platinum band type sensor, thermistor type sensors, resistive heater or the use of potting compound. Ishik<sup>h</sup>kara et al teach the equivalence of blunt and pointed <sup>n</sup> peripheries and the use of irrigation. It would have been obvious to the artisan of ordinary skill to employ a blunt periphery and irrigation in the device of Makower, since these can function similarly and provide surface cooling, respectively, and to employ the sensors, heater, electrode material, sensor location and potting compound fixation, since these not critical, provide no unexpected result and are notorious throughout the art for performing these functions, official of which has been taken, thus producing a device such as claimed.

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The submission of the terminal disclaimer is noted, however the Disclaimer has not yet been processed and until such has occurred the double patenting rejection must be maintained and is hereby repeated.

Applicant argues that regarding Makower "the treatment needle extends off-axis<sup>3</sup> from ~~the~~<sup>2</sup> periphery of the distal tip..." The indefiniteness of the term coaxial as used in the claims aside the Examiner must respectfully submit that the needle of Makower, since it is the device through which the energy is supplied to the tissue, can clearly be read as the energy delivery device. Clearly the device is guidable and position able, else it could only arrive at the desired treatment site through sheer chance.

Applicants arguments regarding Ishikara are noted. However, it is still Examiner's position that the showing of the equivalence of the sharp and blunt ends on the treatment probe is combinable with Makower under 35 U.S.C. 103 to produce a device having the three main elements is applicants independent claims.

In compliance with applicants request, the Examiner provides citation of Sogawa et al (US 5,168,880); and Turner et al (US 5,344,435) which teach sensors as argued by applicant, although it is unclear in what specific respect the sensors of Makower do not fulfill the description set forth in the two full paragraphs of the disclosure or how the temperature sensors of Eggers et al (US 5,366,443) do not fulfill recitation in the claims.

Since the rejection relying on Edwards ('490) has been withdrawn, the arguments drawn thereto are moot.

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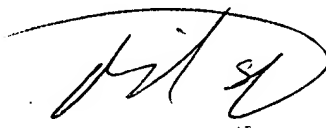
Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw  
January 27, 2000



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330